

REMARKS

Claim Amendments

Applicants have amended claims 37, 54, 57, 62, 71, and 72, and cancelled claims 48 and 65 without prejudice or disclaimer of their subject matter. Support for the amendments to claims 37 and 54 can be found in claims 48 and 65, now cancelled, and in the specification at, for example, p. 29, lines 2-10. Support for the amendments to claim 57 can be found in the specification, for example, at p. 17, line 22 to p. 8, line 8, and Fig. 4. Claims 62, 71, and 72 have been amended to correct informalities and improve form. No new matter has been introduced. Upon entry of this Amendment, claims 37-47, 49-64, and 66-72 are pending and under examination.

Office Action

Applicants respectfully traverse the following actions:

- (a) objection of claims 71 and 72 because of informalities;
- (b) rejection of claims 54-70¹ under 35 U.S.C. § 112, second paragraph, as purportedly being indefinite;
- (c) rejection of claims 37-39, 46-51, 54-56, 63-68, 71, and 72 under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent No. 5,878,231 ("Baehr") in view of U.S. Patent App. Pub. No. 2004/0172557 ("Nakae"); and
- (d) rejection of claims 40-45, 52, 53, 57-62, 69, and 70 under 35 U.S.C. § 103(a) as purportedly being unpatentable over Baehr in view of Nakae and further in view of U.S. Patent No. 7,331,061 ("Ramsey").

Objection to Claims 71 and 72

Applicants respectfully traverse the objection to claims 71 and 72 because of alleged informalities. Specifically, the Office Action alleges that "claims 71-72 do not positively recite

¹ The Office Action does not indicate that claim 70 is rejected in item 7 on p. 5, although, the Office Action does appear to also reject claim 70 under 35 U.S.C. § 112, second paragraph, on p. 6.

claimed limitations. It is suggested that the claims be further amended to clearly recite scope/limitations within the body of the claims.” Office Action, p. 5. Applicants disagree.

Each of claims 71 and 72 is in proper multiple dependent claim form. Multiple dependent claims are explicitly allowed under 35 U.S.C. § 112, second paragraph, which states that “[a] claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.” The specific limitations are incorporated by reference, for example, by referring to “any one of claims 54 to 70” (as recited in claim 71 prior to amendment) and “any one of claims 37 to 53” (as recited in claim 72 prior to amendment). Moreover, since a multiple dependent claim refers to prior claims in the alternative, it may be impractical to recite the specific features in the body of the multiple dependent claim because features vary among the prior claims, as in the case of claims 71 and 72.

The current form of multiple dependent claims 71 and 72 fully satisfies the requirements of 35 U.S.C. § 112, second paragraph, and any other pertinent requirements set forth in the M.P.E.P. *See, e.g.*, M.P.E.P. § 608.01(n).

The Office Action also objected to claim 72 because of the feature “a program product loadable into a memory of at least one computer and including software portions for performing.” Office Action, p. 5. Without conceding to the Office’s allegation, and solely for the purpose of advancing prosecution, Applicants amended claim 72 as indicated herein.

Applicants therefore respectfully request withdrawal of the objection.

Rejection of Claims 54-70 under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully traverse the rejection of claims 54-64 and 66-70 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The rejection of claim 65 has been rendered moot by virtue of the cancellation of this claim.

Specifically, the Office Action alleged that the phrase “communication module

configured for,” as recited in claims 54-56, 58, 61, 62, 69, and 70, the phrase “firewall module configured for,” as recited in claim 57, and the phrase “test system are configured to,” as recited in claims 63, 65, 67, and 68, contain

phrase[s] similar to “means for” or “step for” or a non-structural term coupled with functional language, but it is modified by some structure, material, or acts recited in the claim It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function because there is no corresponding algorithm disclosed in the specification It is unclear as to how the claimed means-plus functions are performed and what corresponding structures and/or algorithms are utilized to perform said claimed steps. As a result, the aforementioned drawings do not provide sufficient structure for performing claimed functions....

Office Action, p. 6.

Applicants disagree with the Office Action’s allegations. Nevertheless, solely for the purpose of advancing the prosecution, Applicants have amended claims 54 to recite “a communication module comprising a first interface configured for directing . . .” and amended claim 57 to recite “a firewall module connected with a second interface and configured for blocking . . .” In light of these amendments, these claims do not invoke § 112, ¶ 6.

Regarding claim 63, which recites “[t]he system of claim 54, wherein said test facilities in said test system are configured to . . .,” Applicants disagree with the Office Action’s allegation that the phrase “said test system are configured to . . .” triggers § 112, ¶ 6. Claim 63 depends from claim 54, which recites “a test system comprising test facilities replicating at least one of said machines in said set.” It is clear from this recitation in claim 54 that the phrase “test system” connote sufficient structure to one of ordinary skill in the art, and accordingly, § 112, ¶ 6 does not apply to the phrase “test system” recited in claim 54. Therefore, the phrase “said test system are configured to . . .” as recited in claim 63 does not invoke § 112, ¶ 6.

Claims 54-64 and 66-70, either as previously presented or as amended herein, fully

satisfy the requirements set forth under 35 U.S.C. § 112, second paragraph. Applicants therefore respectfully request withdrawal of the rejection.

Rejection of Claims 37-39, 46-51, 54-56, 63-68, 71, and 72 under 35 U.S.C. § 103(a)

Applicants request reconsideration and withdrawal of the rejection of claims 37-39, 46, 47, 49-51, 54-56, 63, 64, 66-68, 71, and 72 under 35 U.S.C. § 103(a) as being unpatentable over Bachr in view of Nakae. The rejection of claims 48 and 65 has been rendered moot by virtue of their cancellation.

The Office Action has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). A *prima facie* case of obviousness has not been established, and the burden thus remains with the Office.

Particularly, the Office Action has not properly determined the scope and content of the prior art, at least because the Office Action incorrectly interpreted the content of the cited references. In addition, the Office Action has not properly ascertained the differences between the claimed invention and the prior art, at least because the Office Action has not properly interpreted the prior art by considering *both* the invention *and* the prior art *as a whole*. See M.P.E.P. § 2141(II)(B).

Amended independent claim 37 recites, in part,

- ii) in the absence of an adverse effect, directing the communication entities not having the adverse effect to said set of machines, and inhibiting said test facilities from providing a response to said traffic.

Baehr and Nakae, whether taken alone or in combination, do not teach or suggest the above-quoted features recited in claim 37. For example, in contrast to amended claim 37, Baehr discloses that

[i]f the packet's intended destination is a host machine on the private network, it may instead be sent aside to a preconfigured host machine on the proxy network, which executes appropriate operations that the actual host would execute, or different operations as desired. The proxy host generates responses using the IP address of the actual host, so the existence of the proxy network is not detectable.

Baehr, col. 2, lines 25-31 (emphasis added). Baehr also discloses that “[u]pon execution of such operations, a proxy host may then return a given packet to the sender, i.e. send the packet off with the original sender's address as the destination.” *Id.*, col. 8, lines 17-20 (emphasis added). Thus, Baehr at most teaches that in the absence of adverse effect, the proxy host at least has an option of (e.g., “may then return”), and therefore is not inhibited from, providing responses to the sender. In contrast, amended claim 37 recites “in the absence of an adverse effect, directing the communication entities not having the adverse effect to said set of machines, and inhibiting said test facilities from providing a response to said traffic” (emphases added).

Nakae does not cure the deficiencies of Baehr. The Office Action alleged that Nakae's “decoy unit 2” constitutes the claimed “test facilities.” *See* Office Action, pp. 10-11. Nakae, discloses that “when an attack has been detected by the decoy unit 2, the connection is immediately blocked.” Nakae, ¶ [0449] (emphasis added). Nakae, however, does not teach or suggest “in the absence of an adverse effect, directing the communication entities not having the adverse effect to said set of machines, and inhibiting said test facilities from providing a response to said traffic,” as recited in amended claim 37 (emphases added). Accordingly, Nakae does not cure the deficiencies of Baehr.

Therefore, Baehr and Nakae, whether taken alone or in combination, do not teach or suggest each and every feature of amended independent claims 37. Thus, claims 37 is nonobvious and should be allowable over Baehr and Nakae. Although of different scope, amended independent claim 54 recites features similar to those discussed above in connection with claim 37. Therefore, claim 54 should also be allowable over Baehr and Nakae for at least the same reasons discussed above with respect to claim 37. Dependent claims 38, 39, 46, 47, 49-51, 55, 56, 63, 64, 66-68, 71, and 72 should also be allowable over the cited references at least by virtue of their respective dependence from base claim 37 or 54. Accordingly, Applicants request withdrawal of the rejection.

Rejection of Claims 40-45, 52, 53, 57-62, 69, and 70 under 35 U.S.C. § 103(a)

Applicants request reconsideration and withdrawal of the rejection of claims 40-45, 52, 53, 57-62, 69, and 70 under 35 U.S.C. § 103(a) as being unpatentable over Baehr in view of Nakae and further in view of Ramsey.

As explained above, Baehr and Nakae, whether taken alone or in combination, do not teach or suggest each and every feature recited in claim 37. Ramsey does not cure the deficiencies of Baehr and Nakae, because Ramsey does not teach or suggest, among other features, does not teach or suggest “in the absence of an adverse effect, directing the communication entities not having the adverse effect to said set of machines, and inhibiting said test facilities from providing a response to said traffic,” as recited in amended claim 37 (emphases added).

Therefore, Baehr, Nakae, and Ramsey, whether taken alone or in any combination, do not teach or suggest each and every feature of amended independent claim 37. Thus, claims 37 is nonobvious and should be allowable over Baehr, Nakae, and Ramsey. Although of different scope, amended independent claim 54 recites features similar to those discussed above in

connection with claim 37. Therefore, claim 54 should also be allowable over the cited references for at least the same reasons discussed above with respect to claim 37. Dependent claims 40-45, 52, 53, 57-62, 69, and 70 should also be allowable over the cited references at least by virtue of their respective dependence from base claim 37 or 54. Accordingly, Applicants request withdrawal of the rejection.

Conclusion

Applicants request reconsideration and withdrawal of the objection and rejections. Pending claims 37-47, 49-64, and 66-72 are in condition for allowance, and Applicants request a favorable action.

The Office Action contains a number of statements reflecting characterizations of the cited references and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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